

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 8/29/2011 have been fully considered but they are not persuasive.

Applicant's argument that the layer of Pervan is not one piece with a bordering and that the layers 30 and 36a could not be formed by foaming or spraying is not persuasive. The intermediate layer 36a or 30 are permanently connected to and used with the bordering (36a,20,21 or 80,81,20,21) for forming the one-piece board and therefore since they are connected and used as one piece and form a one-piece board they are considered to be one piece. Applicant's arguments that they cannot be made by foaming or spraying are not persuasive. Firstly, the patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). And secondly, Applicant's assertion amounts to a mere allegation that they are not capable of being made by foaming or spraying and is not supported by any fact or evidence.

### ***Election/Restrictions***

Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claim is drawing to a method, where the original claim is drawn to a product. They are distinct

for at least the reason that the method does not require that the intermediate layer and border are one-piece.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1,4,6-7,9-17,19-22 are rejected under 35 U.S.C. 102(a)as being anticipated by Pervan et al (WO03078761).**

Claims 1,4, 19-21. Pervan et al disclose a building component for forming floor and/or wall coverings, comprising: a support layer (32) for placement on a floor or a wall to be covered; an upper layer (31) supported by the support layer and including at least one coating element forming a visible upper surface of the building component; an intermediate layer (either 36a or 30) arranged between and connecting the support layer and the upper layer; elastic devices for connecting (8,9,10,12) the building component to other such building components applied to the floor or a wall; and a bordering (either 36a,20,21 as seen in figures 6a,b; or 80,81,20,21 as seen in figure 6c) encircling an entire periphery of the building component (as seen in figure 7a) and

forming a visible filling at the visible upper surface of joints between coating elements of the upper layers of the building component and adjacent other such building components connected to the building component by said devices (as seen in figures 6-7). Wherein the intermediate layer and the bordering are one piece (as noted above).

It should be noted that the limitations "wherein the intermediate layer and the bordering are simultaneously formed in a molding cavity of a tool by foaming or spraying onto the support layer and the at least one coating element" and "the intermediate layer is foamed or sprayed" are considered a product-by-process limitation. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695,698, 227 USPQ 964, 966 (Fed.Cir.1985).

Claim 6. The building component according to claim 1, wherein the width of the bordering encircling the building component is half as wide as the width of joints between several coating elements (as seen in figures 6-7; page 21, lines 6-15).

Claim 7. The building component according to claim 1, wherein the intermediate layer is made of an elastic and/or water-resistant material (where pages 19-20 disclose different elastic or water-resistant materials for the seals 36 or 80,81 ).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood

(as disclosed throughout the disclosure the coating element is made of a plastic with metal - aluminum oxide).

Claim 10. The building component according to claim 1, wherein the devices for connection of the building components are formed together to the intermediate layer in one piece and/or the intermediate layer is foamed or sprayed on separate similar elements (as seen in the figures and noted in the disclosure element 36 is together with the intermediate layer in one piece and elements 80,81 are disposed on separate similar elements).

It should be noted that claim 10 contains product-by-process limitations (where "the building components are formed by elements that are molded together" and "... is foamed or sprayed" are process limitations). The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

Claim 11. The building component according to claim 1 wherein the devices for connecting tongue-and-groove joints (as seen in the figures and noted throughout the disclosure).

Claim 12. The building component according to claim 11, wherein the tongue and groove joints include a groove formed at two sides which are perpendicular relative to

each other and a tongue formed at the sides opposing these sides (as seen in figure 7a).

Claim 13. The building component according to claim 10, wherein the connector devices are engaging connector devices are provided (12,8).

Claim 14. The building component according to claim 11, wherein the groove is formed between the support layer and the upper layer encompassing the coating element (as seen figures 6-7).

Claim 15. The building component according to claim 10, wherein the edges of the support layer and of the upper layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figures 6-7 the edges of the upper layer are offset from the edges of the support layer).

Claim 16. The building component according to claim 11, wherein an element having the tongue or groove (9,10) is connected in one piece with the intermediate layer.

Claim 17. The building component according to claim 1, wherein the support layer has a surface profile and/or a soft, ductile coating on its side facing away from the upper layer which is connected to the support layer (where the support layer has a surface profile).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (where page 11, at lines 35-37 discloses that the floorboard can exhibit a wave, or curved, shape).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pervan et al (W003078761) in view of Miller et al (20040031226).**

Claim 8. Pervan discloses the building component according to claim 1 but does not expressly disclose that the support layer is made of recycling material. However, at pages 3-5 Pervan discloses that various suitable materials may be utilized in manufacturing the device, depending on the particular attributes desired. Further, it is common and well known in the flooring art to make support/backing layers of recycled materials. For example Miller discloses a floorboard having a backing layer 16 made of recycled materials (paragraph 0021). Therefore in view of the prior art it Would have been obvious to one of ordinary skill in the art to modify the backing layer of Pervan to be made of recycled materials to be more environmentally conscious and appeal to a "green" or eco friendly/minded consumer.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pervan et al (WO03078761) in view of Milborn (2548036).**

Claim 18. Pervan et al discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component in the support layer. Milborn discloses a panel

for use in flooring having layers and pipes disposed in a support layer for heating a floor made of the panels (see figures; disclosure). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Pervan et al. to have the pipes as disclosed by Milborn to incorporate heating/cooling into the building component to provide efficient and space-saving thermal elements to a building.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Friday, 9:00am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jessica Laux/  
Primary Examiner, Art Unit 3635